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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86196263
Applicant	Shelter Mutual Insurance Company
Applied for Mark	AMERICAN SHIELD INSURANCE
Correspondence Address	BRIAN R MCGINLEY DENTONS US LLP PO BOX 61080 CHICAGO, IL 60606-1080 UNITED STATES trademarks.us@dentons.com, brian.mcginley@dentons.com, an-ita.hansen@dentons.com
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Filer's Name	Brian R. McGinley
Filer's e-mail	trademarks.us@dentons.com, brian.mcginley@dentons.com, an-ita.hansen@dentons.com, kate.hart@dentons.com
Signature	/brian r mcginley/
Date	08/21/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of:)	
)	
Shelter Mutual Insurance Company)	Examining Attorney:
)	
Serial No. 86/196,263)	
)	Law Office 110
Filed: February 18, 2014)	Deborah Meiners, Esq.
)	
Mark: AMERICAN SHIELD INSURANCE)	Our Ref.: 70000404.0023
)	Dated: August 21, 2015

APPLICANT’S APPEAL BRIEF

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I. INTRODUCTION

Pursuant to TBMP § 1203.02 and 15 U.S.C. § 1070, Applicant submits this Appeal Brief in support of its Notice of Appeal filed with the Trademark Trial and Appeal Board (“the Board”) on May 14, 2015. Applicant appeals the Examining Attorney’s final refusal to register the trademark AMERICAN SHIELD INSURANCE¹, Serial No. 86/196,263, covering various insurance underwriting services and banking services in IC 036 (“Applicant’s Mark”). As set forth below, Applicant respectfully submits that there is no likelihood of confusion with Applicant’s Mark and any of the Cited Marks.

Applicant Shelter Mutual Insurance Company, a Missouri corporation, is known to consumers and in the trade as the Shelter Insurance® group of companies. Since opening its doors in 1946, the Shelter Insurance® group of companies has become one of the most successfully and financially sound insurance underwriters and provider of insurance services in the country. Since at least as early as 1981 Applicant has promoted its insurance services in association with the mark “SHIELD” as well as various ‘shield’ logos/designs, such as (and without limitation) the following:

	<p>SHIELD OF SHELTER (& Design)³ (depicted in use in the photo below on the right, from 1981)</p> 
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The Examining Attorney has cited five (5) US registrations as creating a likelihood of confusion with the present application for AMERICAN SHIELD INSURANCE, as follows (individually, each may be referred to as a “Cited Mark”; collectively “Cited Marks”):

¹ Applicant *disclaims* exclusive rights to the terms "AMERICAN" and "INSURANCE", apart from the mark as shown.

² Registered as US Reg. Nos. 1,760,261, 1,760,262, 1,758,727.

³ Registered as US Reg. No. 1,647,030.

<u>Cited Marks</u>	<u>US Reg. No.</u>
	1,427,790 ⁴
AMERICAN HOME SHIELD	1,956,992 ⁵
	4,140,212 ⁶
AMERICAN HOME SHIELD	4,170,524 ⁷
	4,234,976 ⁸

The Cited Marks are commonly owned and cover various services primarily relating to home and real estate warranty services, home repair and preventative maintenance services, as detailed further below. Applicant respectfully traverses the Examiner's objections, respectfully submits that the Examiner has failed to establish by a preponderance of the evidence that a likelihood of confusion exists between Applicant's Mark, and any of the Cited Marks, and respectfully requests that the Board reverse the Examining Attorney's refusal and issue a decision finding that no likelihood of confusion exists between Applicant's Mark and any of the Cited Marks.

⁴ In this Cited Mark, the registrant **disclaims** exclusive rights to the term "**HOME**" apart from the mark as shown.

⁵ In this Cited Mark, the registrant provided a statement of **acquired distinctiveness under section 2(f)** as to the terms "**AMERICAN HOME**".

⁶ In this Cited Mark, the registrant **disclaims** exclusive rights to the terms "**AMERICAN HOME**" apart from the mark as shown.

⁷ In this Cited Mark, the registrant **disclaims** exclusive rights to the terms "**AMERICAN HOME**" apart from the mark as shown.

⁸ In this Cited Mark, the registrant **disclaims** exclusive rights to the terms "**AMERICAN HOME**" apart from the mark as shown.

II. FACTUAL BACKGROUND

On February 18, 2014, Applicant filed a trademark application under section 1(b) for “Providing insurance underwriting in the fields of life, home, auto, business, personal liability and boating; providing on-line insurance underwriting in the fields of life, home, auto, business, personal liability and boating; banking services and investment services; providing online banking services; insurance brokerage and financing services” in International Class 36 (the “Application”). On June 3, 2014, the Examining Attorney issued an Office Action: (1) citing potential likelihood of confusion with the Cited Marks; (2) objecting to the identification of goods as being indefinite; and (3) requiring a disclaimer of the wording “AMERICAN” and “INSURANCE” apart from the mark⁹.

On October 24, 2014, Applicant filed a Response to Office Action addressing the issues raised therein by: (1) presenting arguments and evidence against the likelihood of confusion refusal based upon the Cited Marks due to (i) the differences between the respective services; (ii) the differences between the marks; and (iii) the existence of third party registrations for marks containing “AMERICAN” and/or “SHIELD” that coexist with the Cited Marks; (2) amending the identification of goods in International Class 36 with an express exclusion: *"all of the foregoing excluding home warranty and real estate warranty services" (emphasis added)* and (3) disclaiming the exclusive right to use “AMERICAN” and “INSURANCE” apart from the mark as shown.




On November 15, 2014, the Examining Attorney issued a Final Office Action maintaining the likelihood of confusion objection, reiterating the position that the parties’ respective marks were similar containing the terms “AMERICAN” and “SHIELD” and further indicating Applicant’s introduction of third-party registrations to support the argument that “AMERICAN” and “SHIELD” are widely used is entitled to little weight in evaluating the marks for likelihood of confusion because according to the Examiner they do not show “actual use in the marketplace or that consumers are accustomed to seeing


⁹ The Examiner concludes in the First Office Action that the term "AMERICAN" is "merely descriptive as merely describing a geographic location" of Applicant's services. Applicant complied with the Examiner's disclaimer request.

them”. The Examining Attorney further noted that despite Applicant’s specific exclusion of the Registrant’s services, the parties’ respective services were purportedly “closely related.”

On May 14, 2015, Applicant timely filed a Request for Reconsideration, traversing the Examiner’s likelihood of confusion objections and requesting withdrawal of the same. Applicant further identified numerous additional third party registered rights of the common terms “AMERICAN” and “SHIELD,” which further support Applicant’s position that no likelihood of confusion exists. Applicant identified in IC 036 alone there exists in approximately 1,488 registrations and applications that include the term “AMERICAN” (or a variation thereon), of which in excess of 1,300 of these are currently registered; in IC 036 alone Applicant noted there exists approximately 193 registrations and applications that include the term “SHIELD” (or a variation thereon), in excess of 160 of these currently registered.

Applicant further made of record its long standing rights and consumer and trade recognition with the term SHIELD and related “Shield” logos, acting as a source identifier for Applicant for substantially identical and overlapping services to the present Application, as follows:

<u>Applicant’s Mark:</u>	<u>US Reg. No.:</u>	<u>Reg Date:</u>
PLATINUM SHIELD	1,361,001	January 22, 1985
	1,647,030	June 4, 1991
	1,760,261	March 23, 1993
	1,760,262	March 23, 1993

	1,758,727	March 16, 1993
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On June 21, 2015, the Examining Attorney denied Applicant's Request for Reconsideration. On May 14, 2015, Applicant timely filed Notice of Appeal. Applicant's arguments in support of registration of its Application and traversing the Examiner's objections are as follows:

III. ARGUMENT

A. NO LIKELIHOOD OF CONFUSION EXISTS BETWEEN APPLICANT'S MARK AND ANY OF THE CITED MARKS.

Applicant respectfully submits that its mark AMERICAN SHIELD INSURANCE does not create a likelihood of confusion with any of the Cited Marks, as defined in Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). The Court of Customs and Patent Appeals identified several factors to be considered in determining whether a likelihood of confusion exists under Section 2(d) of the Lanham Act. The factors that are relevant to the present issue include: (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) the nature and similarity of the goods and services; (3) the conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing; (4) the number and nature of similar marks in use on similar goods and services; (5) the nature and extent of any actual confusion; (6) the length of time during, and conditions under which, there has been concurrent use without evidence of actual confusion; and (7) the extent of potential confusion, whether substantial or *de minimis*. *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). The fundamental inquiry in determining likelihood of confusion goes to the cumulative effect of the differences in the marks and the relevant goods or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976).

Applicant respectfully submits that no likelihood of confusion exists because among other things the marks are sufficiently distinguishable based on differences in the marks, the overall commercial

impression of the marks, and the relative strength of the marks. In Applicant's Mark "AMERICAN SHIELD" modifies the term "INSURANCE". Applicant's Mark includes the term "INSURANCE" which does not appear in any of the Cited Marks. The inclusion of the term "INSURANCE" in Applicant's Mark provides a clear indication of the nature of the Applicant's services to consumers and the trade, e.g., insurance underwriting services.

In contrast, each of the Cited Marks contain the terms "HOME SHIELD", with the term AMERICAN modifying the terms "HOME SHIELD"¹⁰. The terms "HOME SHIELD" are suggestive of the services associated with the Cited Marks (e.g., home warranty services, home repair services, and the like). Applicant's Mark and the Cited Marks share the common term "AMERICAN", which is seen as a laudatory and/or geographically descriptive term, and is in widespread use by scores and scores of third parties, all as discussed more below. The Cited Marks include the term "HOME", which is suggestive to consumers and the trade of the services associated with the Cited Marks and which is not present in the Applicant's Mark. Applicant's mark includes the term "INSURANCE", which is not present in any of the Cited Marks and serves to identify to consumers and the trade the nature of Applicant's services. Applicant's Mark and the Cited Marks include the common term "SHIELD", a term which is long associated with Applicant and its insurance underwriting services as evidenced in part by Applicant's US registrations which have been made of record.

Additionally, as discussed more below, Applicant's services are sufficiently different from the services in the Cited Marks to avoid a likelihood of confusion, are relatively expensive and are directed to sophisticated, discerning purchasers who are not likely to be confused. Consumers are accustomed to distinguishing between similar marks containing the terms AMERICAN and/or SHIELD for similar services and will look to additional distinguishing terms including Applicant's term INSURANCE and Registrant's term HOME to distinguish among other marks. Applicant submits that the Examining Attorney has failed to give appropriate weight to each of the relevant *DuPont* factors that demonstrate that no likelihood of confusion exists between Applicant's Mark and the Cited Marks.

¹⁰ Three of the five Cited Mark registrations include additional terms (e.g., "AHS" and/or design elements).

1. Applicant's Mark and the Cited Marks are Different in Appearance, Sound, Connotation, and Commercial Impression.

Similarity in appearance, sound, and commercial impression arises from the overall impression of the elements comprising the mark. *In re Hearst Corp.*, 25 U.S.P.Q.2d 1238, 1239 (Fed. Cir. 1992). “Marks tend to be perceived in their entirety, and all components thereof must be given appropriate weight.” *Id.* Thus, two marks must be compared in their entirety, not dissected or split up into its component parts and each part then compared with corresponding parts of the challenging mark to determine the likelihood of confusion. It is the impression that the mark as a whole creates on the average reasonably prudent purchaser and not the parts thereof, that is important. *See, e.g., In re Produits de Beatue – Parfums Jean D’Aveze*, 225 USPQ 283, 284 (T.T.A.B. 1984). “The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail. For this reason it should be considered in its entirety.” *Beckwith*, 252 U.S. at 545-46. Courts have found that when analyzing two marks in their entirety, there may be no confusion even when a junior user’s mark contains the whole of another’s mark. *See, e.g., In re Merchandising Motivation, Inc.*, 184 U.S.P.Q. 364 (T.T.A.B. 1974) (MMI MENSWEAR found not to be confusingly similar to MEN’S WEAR). The marks in the instant case are sufficiently different to avoid a likelihood of confusion.

The Cited Marks are composed of the following terms (and designs): AMERICAN HOME



It is immediately clear that the several of the Cited Marks (Registration Nos. 1,427,790; 4,140,212; and 4,234,976) contain a significant and prominent design element. Specifically, the Cited (design) Marks are comprised of a depiction of a shield and a home next to the wording AMERICAN HOME SHIELD. The Examining Attorney’s refusal discounts the significance of the Cited Marks’ home and shield design, Registrant’s inclusion of the additional significant term HOME, and the Applicant’s inclusion of the additional significant term INSURANCE, which are substantial factors. Rather, the

Examining Attorney based a disproportionate weight on the fact that both the Applicant's Mark and Cited Marks contain the shared literal elements AMERICAN and SHIELD.

Applicant's Mark and the Cited Marks include the common term "AMERICAN". In the trademark context the term AMERICAN is commonly and routinely viewed as descriptive and/or laudatory. *See, e.g.*, TMEP § 1209.03(k); TMEP § 1210.02(b)(iv). Indeed in the present Application the Examiner indicates the term AMERICAN "can be viewed as laudatory"¹¹ and required a disclaimer of exclusive rights to the term, which Applicant has made of record. Similarly, in the case of the Cited marks, and notably in particular in relation to the two word marks for AMERICAN HOME SHIELD, the owner either disclaimed exclusive rights to the term AMERICAN or submitted a declaration under section 2(f) as to the term AMERICAN to overcome a merely descriptiveness objection. These facts coupled with the extensive third party usage and registration of marks that include the term AMERICAN for related services strongly supports that position that the inclusion of the common term AMERICAN in Applicant's Mark and the Cited Marks should not be given any significant weight in support of a likelihood of confusion finding. Indeed it cannot be refuted that the term does not serve as a source identifier for any single owner.

Applicant's Mark and the Cited Marks include the common term SHIELD. The term SHIELD has used for decades by Applicant in connection with its insurance services and is associated with Applicant by consumers and the trade. By way of example Applicant has made of record US Reg. No. 1,361,001 for PLATINUM SHIELD (issued January 22, 1985), US Reg. No. 1,647,030 for SHIELD OF SHELTER (& Design) (issued June 4, 1991) and several other US registrations which include a Shield device design element / logo. Consumers and the trade are familiar with and associate the use of "SHIELD" with Applicant in connection with insurance services. A trademark owner's prior registrations can be relevant to show consumer association of a mark or term as to a later filed application for registration of a similar mark. *See, e.g.*, TMEP § 1212.04.

¹¹ *See, e.g.*, Examining Attorney's June 21, 2015 Denial of Request for Reconsideration.

In addition, as discussed more above, when the respective composite marks are considered the term SHIELD takes on a different and distinguishable meaning to consumers and the trade. In Applicant's Mark the term "AMERICAN SHIELD" modifies "INSURANCE", which evokes an impression of insurance services of a high quality, e.g., bearing a badge (the AMERICAN SHIELD) of approval. In the Cited Marks the term HOME SHIELD strongly suggests the services that are covered, e.g. home warranty, real estate warranty, repair services, etc. (e.g., it conveys an impression of defending one's home against events within such warranty services). In addition, the term "SHIELD" is in use in various marks by at least dozens and dozens of third parties for related services, as discussed more below.

These aforementioned facts strongly support that position that the inclusion of the common term SHIELD in Applicant's Mark and the Cited Marks should not be given any significant weight in support of a likelihood of confusion finding. In essence, the Examining Attorney has improperly dissected and split up Applicant's Mark and the Cited Marks into component parts and compared only the parties' respective uses of AMERICAN and SHIELD. When viewed as a whole, Applicant's Mark is readily distinguishable from the Cited Marks. Although Applicant's Mark includes the same terms AMERICAN and SHIELD as the Cited Marks, when viewing Applicant's Mark in its entirety, the consumer's eyes focus on not only on the term INSURANCE in Applicant's Mark, but also on the mark AMERICAN SHIELD INSURANCE as a whole, rather than the individual words.

In the present case the only similarity between Applicant's Mark and the Cited Marks is the inclusion of the terms "AMERICAN" and "SHIELD". The inclusion of one or more similar terms between competing marks does not necessitate a finding of confusing similarity. *In re Hearst*, 25 U.S.P.Q.2d at 1239. In *Hearst*, the Federal Circuit held that the word marks VARGA GIRL and VARGAS, both used in connection with calendars and related goods in class 16, were sufficiently different to negate any likelihood of confusion. *Id.*; accord *In re Dayco Products-Eagle Motive Inc.*, 9 U.S.P.Q.2d 1910 (T.T.A.B. 1988) (IMPERIAL for automobile and structural parts and IMPERIAL for automotive products held not confusingly similar).

Because consumers will view both Applicant's Mark and the Cited Marks in their entirety, the inclusion of the different, distinctive terms will prevent confusion. This case is analogous to *In re Merchandising Motivation, Inc.*, where MIMI MENSWEAR was found to not be confusingly similar to MEN'S WEAR, despite the fact that the junior user incorporated the entirety of the prior user's mark. Applicant's Mark and the Cited Mark are even more different than the marks in *In re Merchandising Motivation* as both Applicant's Mark and the Cited Marks contain additional elements that distinguish the marks.

Applicant also brings the Board's attention to the case of *Color Key Corp. v. Color 1 Assoc., Inc.*, 219 U.S.P.Q. 936, 943 (T.T.A.B. 1983), in which the Board held that variations in the highly suggestive mark COLOR 1 and the mark COLOR KEY 1 served to render the marks distinguishable for nearly identical goods and services relating to cosmetics. *See also, e.g., Pacquin-Lester Co. v. Pharmaceuticals, Inc.*, 179 U.S.P.Q. 45, 46 (C.C.P.A. 1973) (no likelihood of confusion between SILK for face cream and SILK 'N SATIN for beauty lotion and bath oil for hands and skin); *Ashe v. Pepsico Inc.*, 205 U.S.P.Q. 451 (S.D.N.Y. 1979) (ADVANTAGE ASHE for tennis classes not confusingly similar to ADVANTAGE for tennis rackets); and *Jewel Companies, Inc. v. Jewelcor Incorporated*, 207 U.S.P.Q. 68 (DCMD Florida 1980) (JEWELCOR for retail catalog showrooms not confusingly similar to JEWEL for catalog home shopping).

Further, the Federal Circuit has held that the mark CRYSTAL CREEK for wine was not confusingly similar to CRISTAL for champagne, even though the goods were related, in the same class, and traveled in the same commercial channels, because the additional element "CREEK" gave rise to a different commercial connotation than that of the singular word mark "CRISTAL." *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375 (Fed. Cir. 1998). The very same can be said for Applicant's Mark.

In addition, the C.C.P.A. held in *Interstate Brands Corp. v. Celestial Seasonings, Inc.* that the mark RED ZINGER was not confusingly similar to the registered mark ZINGERS, even when both were used on products sold to consumers through similar channels. 576 F.2d 926, 928 (C.C.P.A. 1978). The

court noted that the additional word element RED could not be ignored, in light of the stricture that marks be considered in their entirety. *Id.* That case involved two word marks, with one of the words being common to both marks. If the color adjective RED was enough to distinguish those two marks, the inclusion of the “INSURANCE” element in Applicant’s Mark and the “HOME” element in the Cited Marks, as well as the design element of several of the Cited Marks, is more than enough to distinguish the parties’ respective marks.

Finally, and particularly instructive here, is the Federal Circuit’s decision in *In Electrolyte Labs*. The court well noted that the respective parties’ goods were similar and enjoyed similar channels of trade. Indeed, both parties produced vitamin supplements sold in retail channels. *Id.* at 647. Despite these obvious similarities, the court nonetheless emphasized the axiom that the marks must be considered in their entirety, and noted the registered mark contained the element “EFF,” not present in the applicant’s mark. *In re Electrolyte Labs., Inc.*, 929 F.2d 645 (Fed. Cir. 1990).

In addition, the “home” and “shield” designs in several of the Cited Marks serve to even further distinguish the Cited Marks from Applicant’s Mark. The home and shield design has a significant impact on the overall appearance, connotation, and commercial impression of the Cited Marks. The Examining Attorney, however, has ignored the additional significant and distinguishing literal element of Applicant’s Mark, and the additional significant and distinguishing literal element and distinctive design of the Cited Marks. In sum, the common word elements in Applicant’s Mark and the Cited Marks simply do not justify a likelihood of confusion refusal.

2. Applicant’s Mark and the Cited Marks Cover Different & Distinguishable Services.

Applicant’s services in IC 036 in the present Application are as follows (emphasis added):

providing insurance underwriting in the fields of life, home, auto, business, personal liability, and boating; providing on-line insurance underwriting in the fields of life, home, auto, business, personal liability, and boating; banking services; investment services, namely, investment banking services and investment consultation services; providing online banking services; insurance brokerage and financing services, ***all of the foregoing excluding home warranty and real estate warranty services***

The Examining Attorney indicates¹² the relevant services in the Cited Marks. On their faces the services associated with Applicant's Mark and the services associated with the Cited Marks are readily distinguishable to consumers and the trade. Applicant provides insurance underwriting services in the fields of life, home, auto, business, personal liability, and boating. These services are well known and understood to comprise casualty losses (e.g., associated with fires, accidental destruction, weather related losses, etc.). In sharp contrast the services associated with the Cited Marks are directed to warranty and repair services, i.e., "warranty services, namely, arranging for repairs and replacement of major home systems, appliances and parts thereof provided by others pursuant to service agreements"; and "preventive maintenance of home systems, appliances and parts thereof". It is well known to consumers (e.g., a homeowner, car owner, boat owner, etc.) and the trade that the provision of an underwritten insurance policy for casualty loss is a different service than routine repairs and/or preventative maintenance on home appliances, for example. By definition, the assets for which a consumer will seek casualty insurance are extremely likely to be important assets to the consumer, and the consumer is going to procure such services with discernment and a high degree of sophistication. Similarly, a consumer procuring home warranty services is going to also procure such services with discernment and a high degree of sophistication.

Even if the marks were, as the Examining Attorney suggests, "nearly identical," it is "well established" that "mere identity of marks...is not alone sufficient to preclude the registration by a subsequent user of even the identical mark for any and all goods or services. This is in accord with the accepted principle of trademark law that a party cannot possess a right in gross in a trademark." *Dap, Inc. v. Litton Indust., Inc.*, 185 U.S.P.Q. 177, 180 (T.T.A.B. 1975). Where the "goods of the respective parties are sufficiently distinct," their "marketing under identical marks would not be likely to cause confusion, mistake, or to deceive," *Dynamics Research Corp. v. Langenau Mfg. Co.*, 704 F.2d 1575, 1576, 217 U.S.P.Q. 649 (Fed. Cir. 1983), and in such a case, "the Board has not hesitated to find an absence of likelihood of confusion, even in the face of identical marks applied to goods used in a common industry."

¹² See Examining Attorney's June 21, 2015 Denial of Request for Reconsideration.

In re Fesco, Inc., 219 U.S.P.Q. 437 (T.T.A.B. 1983) (reversing refusal to register FESCO for farm equipment distributorship services, based on prior FESCO registration for fertilizer processing equipment).

The Examiner attempts to rely on evidence of purported third party registrations that cover both insurance services and warranty services as evidence that consumers could reasonably expect that a particular owner could provide both types of services¹³. On review of the evidence provided in support of such proposition, Applicant notes that the evidence as a whole is *de minimis* and many of the third party marks cited by the Examiner do not support the proposition (e.g., in US Reg. No. 4,510,917, cited by the Examining Attorney, “insurance services, namely underwriting of extended warranty contracts” relates to warranty services, not general insurance underwriting for casualty loss). Moreover, even *arguendo*, if the evidence supports that consumers could or would believe that the same company may offer all of the services set forth in the Applicant’s Mark and the Cited Marks, this is not sufficient to overcome that other factors that exists that will avoid any likelihood of confusion, including for example, differences in the marks, the relative strengths of the marks, the sophistication of consumers and the trade, among other factors.

Even if services associated with the marks were, as the Examining Attorney suggests, “closely related,” numerous decisions have found no likelihood of confusion in situations where the services at issue were more similar than Applicant’s and those in the Cited Marks. *See Electronic Design & Sales, Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 713, 21 U.S.P.Q.2d 1388 (Fed. Cir. 1992) (no confusion between “E.D.S.” computer services and “EDS” battery chargers, even though market overlap existed), *citing with approval Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 U.S.P.Q. 1388 (1st Cir. 1983) (no confusion between ASTRA for cardiovascular drugs, and ASTRA for blood analysis instrument, even though “both parties’ products are used in the medical or health care field” and could even be found in the same hospitals); *accord, Clayton Mark & Co. v. Westinghouse Elec. Corp.*, 356 F.2d 943, 944, 148 U.S.P.Q. 672 (C.C.P.A. 1966) (“we do not see that any

¹³ *See*, Examining Attorney’s June 3, 2014 Office Action.

confusion as to origin of the goods is likely by reason of the factors relied on by appellant, namely, that ‘MARK’ electrical conduit and ‘MARK 75’ circuit breakers may be bought from the same distributors, used by the same contractors, in the same structure, and included in the same specification sheets”).

Applicant’s Mark expressly and specifically *excludes* the core services covered by the Cited Marks. Applicant’s Mark and the Cited Marks are distinguishable based on differences in the services each mark represents. Specifically, Applicant’s description of services are all expressly limited to the fields of insurance, investment, and banking services. Applicant’s customers’ procure insurance underwritten by Applicant on homes, cars, businesses, boats, and very lives, from hazards, such as theft, fire, flood, and other natural and man-made disasters and provides liability protection against lawsuits. The gravamen of these services is such that they are heavily regulated and monitored.

In contrast, the Registrant offers service contracts that provide for repair or replacement in the event of damage resulting from ordinary use or faulty workmanship. Registrant’s services tend to apply to appliances, hot water heaters, HVAC components, and plumbing and electrical systems – items in the home, in contrast to Applicant’s services, which protect the home itself. Home warranties are loosely regulated, if at all, in most states. *See* Exhibit 1 to Response to June 3, 2014 Office Action. The price points for the respective services also differ (which consumers readily appreciate based on having to renew premiums for underwritten insurance on the one hand, and contracts for warranties/repair services on the other).

Additionally, it is well established that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in an applicant’s application vis-à-vis the goods or services recited in the cited registration. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 U.S.P.Q.2d 1813, 1815 (Fed. Cir. 1987); *see also, Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 U.S.P.Q.2d 1783 (Fed. Cir. 1992) (“the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.”);

Applicant's Mark and the Cited Marks are distinguishable based on differences in the services each mark represents. Notably, Applicant's Mark does not include the services identified in the Cited Marks, and the Cited Marks do not include the services identified in Applicant's Mark. Applicant respectfully submits that the Cited Marks' identification of services is considerably narrow, and wholly different from those of the Applicant. Moreover, the Cited Marks do not contain any of the services identified in Applicant's Mark, namely, "providing insurance underwriting in the fields of life, home, auto, business, personal liability, and boating; providing on-line insurance underwriting in the fields of life, home, auto, business, personal liability, and boating; banking services; investment services, namely investment banking services and investment consultation services; providing online banking services; insurance brokerage and financing services, all of the foregoing excluding home warranty and real estate warranty services." Applicant respectfully submits that the Examining Attorney has not provided any evidence that the Cited Marks are famous or that they are entitled to a broader scope of protection for services other than those included in the Cited Marks.

The express exclusion in Applicant's Mark of the services covered by the Cited Marks must cut in Applicant's favor in a likelihood of confusion analysis. Not only are the marks used in connection with different products, the narrowly specified services in the Application and Cited Marks assure that the marks remain separated. Because the services are so distinct in nature, Applicant's services and the services under the Cited Marks are not "reasonably interchangeable by buyers for the same purposes." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, § 24:23 (4th ed.). Thus, the differences in the respective services demonstrate that no confusion is likely with the Cited Marks.

3. Substantial Third Party Registrations Exist Based on Actual Use In Commerce.

The U.S. Patent and Trademark Office has repeatedly recognized that similar uses of marks containing the term "AMERICAN" can co-exist without any likelihood of confusion. The Trademark Electronic Search System (TESS) shows that there exist approximately 1,488 registrations and applications that include the term AMERICAN (or a variation thereon), of which in excess of 1,300 of these are currently registered. *See* Exhibit C to Request for Reconsideration. Similarly, similar uses of

marks containing the term “SHIELD” can co-exist without any likelihood of confusion. The Trademark Electronic Search System (TESS) shows that there exist approximately 193 registrations and applications that include the term SHIELD (or a variation thereon), of which in excess of 160 of these are currently registered. *See* Exhibit C to Request for Reconsideration. Finally, similar uses of marks containing both the terms “AMERICAN” and “SHIELD” can co-exist without any likelihood of confusion. The mark AMERICAN GOLD SHIELD in International Class 036 was approved for publication and registered without even an office action. *See* Exhibit 2 to Response to June 3, 2014 Office Action, pp. 7-11.

Use of “AMERICAN” and of “SHIELD” by numerous applicants and registrants in connection with International Class 036 goods shows that consumers are not confused by these various marks and are fully capable of distinguishing them from one another. Consequently, the number and nature of other “AMERICAN” and “SHIELD” marks used in connection with International Class 036 also weighs in Applicant’s favor.

The Examiner in the November 15, 2014 Final Office Action and June 21, 2014 Request for Reconsideration Denial asserts that evidence of third party registration is “entitled to little weight” since the registrations do not evidence that the marks are in use. Applicant respectfully disagrees with this assertion. For example TMEP § 1207.01(d)(iii), which reads in part as follows, directly contradicts the Examiner’s assertion:

...third-party registrations may be relevant to show that a mark or a portion of a mark is descriptive, suggestive, or so commonly used that the public will look to other elements to distinguish the source of the goods or services. *See, e.g., In re Hartz Hotel Servs., Inc.*, 102 USPQ2d 1150, 1153-54 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Dayco Products-Eagle motive Inc.*, 9 USPQ2d 1910, 1911-12 (TTAB 1988); *Plus Prods. v. Star-Kist Foods, Inc.*, 220 USPQ 541, 544 (TTAB 1983). Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. *See, e.g., Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917, 189 USPQ 693, 694-95 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172, 1174 (TTAB 1987).

TMEP § 1207.01(d)(iii).

Applicable case law further supports this proposition. For example, the Ninth Circuit has the existence of third party marks with similar terms supports a finding of no likely confusion: *Abercrombie & Fitch Co. v. Moose Creek, Inc.*, 486 F.3d 629, 634 n.1 (9th Cir. 2007) (where a crowded field of similar marks for use on similar goods exists, each member of the crowd is relatively weak in its ability to prevent use by others in the crowd). Moreover, a review of the record in the present case of the third party registration evidence submitted¹⁴ reveals the great majority of these registrations were completed based on actual use of the marks in commerce, and an equally significant number of these registrations have post registration section 8 affidavits of record. Such registrations which are based on use in commerce are competent evidence for these purposes. *See, e.g.*, TMEP § 1207.01(d)(iii).

Applicant respectfully submits that the Examiner's factually unsupported assertion that the *third party registrations* are entitled to little probative weight because they do not evidence use of the mark is misplaced both factually and not supported by the applicable law. Applicant submits that these registrations are strong evidence of Applicant's position and support the proposition that no likelihood of confusion exists because the overlapping common terms "AMERICAN" and "SHIELD" between Applicant's Mark and the Cited Marks are commonly used such that members of the public and the trade will look to other distinguishing factors.

4. The Respective Purchasers Are Careful And Not Likely to be Confused.

The price points and costs of the services at issue and the level of care of the consumers who buy them is a factor that further negates any supposed likelihood of confusion between Applicant's Mark and the Cited Marks. Consumers who purchase Applicant's insurance services incur premiums commensurate with the level of protection afforded to coverage of their most valuable assets – and even their very lives. Thus, purchasing Applicant's services is a substantial commitment and one that consumers make only upon careful consideration. There is little to no chance that a consumer investing in Applicant's insurance and underwriting services will mistake them for Registrant's repair- and maintenance-based warranty services for appliances and building systems.

¹⁴ *E.g.*, the evidence submitted with Applicant's October 24, 2014 Response and May 14, 2015 Request for Reconsideration.

Where the goods and/or services provided under competing marks are relatively expensive or otherwise would not be purchased on impulse, the T.T.A.B. has concluded that the targeted consumers are sophisticated, which in turn, lessens the likelihood that confusion will be found. *In re Quality Trans Parts Inc.*, 2005 TTAB LEXIS 510. In this case the T.T.A.B. held that, despite the fact that the marks QUALITY and QUALITEE, in connection with automotive parts, would travel through the same channels of trade and target the same purchasers, “these purchasers are likely to be somewhat sophisticated and careful in their purchasing of these goods, especially in the purchase of Applicant’s transmissions, which we presume to be fairly expensive items which would not be purchased on impulse.” *Id.*, at 12.

“When consumers exercise heightened care in evaluating the relevant products before making purchasing decisions, courts have found there is not a strong likelihood of confusion. Where the relevant products are expensive, or the buyer class consists of sophisticated or professional purchasers, courts have generally not found Lanham Act violations.” *Checkpoint Systems, Inc. v. Check Point Software Technologies*, 269 F.3d 270, 286-87 (3d Cir. 2001) (no likelihood of confusion due to sophistication of purchasers of physical asset security products and services for businesses and computer network security products and services); *EA Eng’g, Sci., and Tech., Inc. v. Envtl. Audit, Inc.*, 12 U.S.P.Q.2d 1294, 1298 (C.D. Cal. 1989) (no likelihood of confusion where services of both parties were highly specialized and involved sophisticated clientele, negotiated contracts generally involving many thousands of dollars, and close working relationships with the client).

Applicant’s services protect the most important personal assets in a purchaser’s life, requiring significant contemplation. Applicant’s services are purchased by consumers after careful selection and consultation in conjunction with purchase of a house, and paid for over the entire lifetime of ownership of the property. Purchasers are seeking to protect their home and treasured belongings from theft, destruction, and natural disasters, not purchasing relatively inexpensive items on a whim without due consideration. As such, the purchasers work closely with Applicant to select and purchase the type and

extent of coverage offered by Applicant, discussing the extent and nature of Applicant's services, which would cause the purchasers to ascertain the actual source of Applicant's services.

Alternatively, Registrant's services are directed to often easily replaceable items *within* a house. Warranties cover refrigerators, air conditioners, and plumbing, for example, not from disasters like tornadoes (like Applicant's services), but from everyday wear and tear. Warranties are most often sold along with such appliances or by real estate agents for plumbing or electrical systems during the purchase of a house. When purchasing a car, a buyer does not typically purchase car insurance from the car dealer – they may buy an extended warranty from the dealership, but seek an outside source for car insurance, like Applicant. This holds true even more so for homes, which are exponentially more expensive and constitute the biggest investment of a homebuyer's lifetime. The respective purchasers are therefore deemed sophisticated and not likely to be confused. Due to the high degree of sophistication and care of the purchasers of Applicant's services and the expense and relationships involved in those purchases, confusion among those purchasers as to the source of the respective services is not likely.

5. Widespread Third-Party Use of AMERICAN and SHIELD Exists.

In considering whether the differences between two marks are sufficient to prevent confusion in a given instance, the strength of the marks and, more particularly, the strength of the features that are common to both marks, must also be considered. Where the features that are common to both marks are weak, even minor additions or changes can effectively negate any confusing similarity. When confronted with commonly used terms in the marketplace (e.g., PREMIUM, NATIONAL, PLUS, AMERICAN, SHIELD, etc.), consumers have been conditioned to expect different sources, especially where there are other differences between the marks and distinctions in the goods. *Nat'l Cable Television Ass'n v. Am. Cinema Editors, Inc.*, 19 U.S.P.Q.2d 1424 (Fed. Cir. 1991) (in such situations, it is reasonable to infer that the relevant public may have become conditioned to draw fine lines, even between sources of arguably related goods/services). Moreover, by permitting numerous registrations for marks comprised in part of the terms "AMERICAN" and/or "SHIELD" to exist concurrently for such closely related services, the

U.S. Patent and Trademark Office has already taken the position that confusion between the marks is not likely due to the other differences between the marks themselves.¹⁵

The public is already accustomed to distinguishing between various “AMERICAN” marks and various “SHIELD” marks used in connection with warranty services, insurance services, and underwriting and other services and will easily differentiate between the Applicant’s Mark and the Cited Marks. These third-party uses of similar marks demonstrate that the Cited Marks are weak and entitled to only a narrow scope of protection. The common use of marks containing “AMERICAN” and/or “SHIELD” shows that the public is accustomed to seeing use of these terms by unrelated entities and can readily distinguish among them. Accordingly, the instant application is not likely to create confusion with these already co-existing uses.

When common terms are frequently used in marks in connection with the same or similar goods or services, the marks are considered weak, as they “exist in a crowded field,” and are entitled to only a narrow scope of protection that is overcome by small differences in the marks. *See* J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 11:85 (4th ed.)

A mark that is hemmed in on all sides by similar marks on similar goods cannot be very ‘distinctive.’ It is merely one of a crowd of marks ... In a ‘crowded’ field of similar marks, each member of the crowd is relatively ‘weak’ in its ability to prevent use by others in the crowd.

The Trademark Trial and Appeal Board and the courts are in accord and have recognized that merely descriptive and weak designations may be entitled to a narrower scope of protection than an entirely arbitrary or coined word. *See In re Box Solutions Corp.*, 79 U.S.P.Q.2d 1953 (T.T.A.B. 2006); *In re Central Soya Company, Inc.*, 220 U.S.P.Q. 914 (T.T.A.B. 1984). A predominant factor when determining the risk of likelihood of confusion is whether the cited mark falls within the category of weak marks. *See, e.g., In re Melville Corp.*, 18 U.S.P.Q.2d 1388 (T.T.A.B. 1991). The weaker the mark, the less likely the risk of confusion between any two specific uses of mark and the narrower the scope of protection afforded each mark incorporating the weak term. *Id.*; TMEP § 1207.01 (c)(iv). Strength of the

¹⁵ Applicant understands that each case is judged on its own facts; however, in the present case where hundreds and hundreds of third party uses of the common term "American" and scores and scores of third party uses of the common term "Shield" exist, this must be considered compelling evidence.

mark is determined by the effect of the mark upon the mind of the consuming public. “A mark that is strong because of its fame or its uniqueness, is more likely to be remembered and more likely to be associated in the public mind with a greater breadth of product or services, than is a mark that is weak because relatively unknown or very like similar marks or very like the name of the product.” *James Burroughs, Ltd. vs. Sign of the Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976). Likewise, in *First Savings Bank FSB vs. First Bank Systems, Inc.*, 40 U.S.P.Q. 2d 1865, 1873 (10th Cir. 1996), the court held that the term FIRST BANK was weak as applied to financial services and concluded that “[w]hen the primary term is weakly protected to begin with, minor alterations may effectively negate any confusing similarity between the... marks.”

In such cases, small differences between marks under review will be sufficient to preclude a likelihood of confusion. *Sun Banks of Florida, Inc. v. Sun Federal Sav. & Loan Assoc.*, 651 F.2d 311, 316 (5th Cir. 1981) (extensive third-party use of SUN was impressive evidence that there would be no likelihood of confusion between SUN BANKS and SUN FEDERAL); *In re Broadway Chicken, Inc.*, 38 U.S.P.Q.2d 1559 (T.T.A.B. 1996) (reversal of refusal to register BROADWAY CHICKEN on the basis of existing registrations for BROADWAY PIZZA and BROADWAY BAR & PIZZA in view of evidence of widespread third party use of BROADWAY in connection with restaurant services); *General Mills Inc. v. Health Valley Foods*, 24 U.S.P.Q.2d 1270 (T.T.A.B. 1992) (finding no likelihood of confusion between marks FIBER ONE for breakfast cereals and FIBER 7 also for breakfast cereals because FIBER mark is widely used in the food industry).

In this case, taking into account the relative strength of the respective marks (which, as set forth below and herein, is relatively “weak” under applicable trademark laws for these purposes), the differences in the parties’ marks take on significant importance in terms of how consumers and the trade will understand the marks.

Additionally, in its Response dated December 3, 2014, Applicant provided evidence of numerous registrations of “AMERICAN” and “SHIELD” in IC 0036 (*see* Exhibit 2 to Response to June 3, 2014 Office Action), including evidence of actual use of many of these marks (*see* Exhibit 3 to Response to

June 3, 2014 Office Action). The terms “AMERICAN” and “SHIELD” are so often used in registered marks in connection with insurance, investment, and warranty services that a “crowded field” exists. Each use is considered weak and entitled to only a narrow scope of protection. The public already is accustomed to distinguishing among many marks containing the terms “AMERICAN” and “SHIELD” for similar services and will easily differentiate between Applicant’s Mark and the Cited Marks.

6. There Is No Actual Confusion or Potential Confusion

Applicant has filed an intent-to-use application for registration. An analysis of all the relevant *DuPont* factors demonstrates that there is no confusion – actual, likely, or potential – that will result from the registration of Applicant’s Mark. Therefore, mere conjecture about possible confusion is simply an insufficient basis to refuse registration to Applicant. Potential confusion is not likely to occur, because Applicant can establish long standing rights and consumer and trade recognition with the term “SHIELD” (and related logos) being a source identifier for Applicant, in connection with substantially identical and overlapping services for which it seeks to register the present mark. Applicant has submitted a claim of ownership on the record that it owns US Registration Numbers 1,361,001; 1,647,030; 1,760,261; 1,760,262; and 1,758,727, and such marks are in use by Applicant. *See, e.g.*, Exhibit B to Request for Reconsideration. These marks and their respective uses have long co-existed along with the Cited Marks, in many cases for decades. It is a natural and logical progression for Applicant to offer its insurance services under an additional mark that also includes the term SHIELD (which consumers already associate with Applicant), as in the present case with AMERICAN SHIELD INSURANCE. Therefore, no confusion is likely to occur as a result of registration of Applicant’s Mark.

IV. CONCLUSION

In light of the forgoing, Applicant respectfully submits that no likelihood of confusion exists between Applicant’s Mark and the Cited Marks. The Examiner’s position relies heavily on the inclusion of the common terms “AMERICAN” and “SHIELD” and the purported relatedness of Applicant’s and Registrant’s services. As Applicant has shown, these common terms are either considered weak source identifiers and therefore entitled to a narrow scope of protection, and/or associated with Applicant already

by virtue of prior uses and registrations. The Examiner's analysis ignores and discounts factors that weigh heavily in Applicant's favor, such as the sophistication of consumers and the conditions under which purchasing decisions are made. The Examiner improperly discounts the weight that should be afforded to the Applicant's express limitation on its services (to exclude home warranty and real estate warranty services) as well as the weight that should be afforded to the substantial evidence of third party usage of related marks for related services. Applicant's Mark and the Cited Marks are visually, phonetically, and connotatively different to such an extent that the respective marks are sufficiently distinguished from each other. Additionally, Applicant's services and Registrant's services are different and Applicant's services are quite expensive and directed to discerning purchasers who are not likely to be confused. Purchasers are accustomed to distinguishing between similar marks containing the terms "AMERICAN" and "SHIELD" for similar services, and have, and will continue to look to additional distinguishing terms including Applicant's term "INSURANCE" and Registrant's term "HOME" and house and shield design to distinguish among other "AMERICAN" or "SHIELD" marks. Applicant respectfully submits that by a preponderance of the evidence it has established that no likelihood of confusion exists between Applicant's Mark and any of the Cited Marks. For the foregoing reasons, Applicant respectfully requests that the Examining Attorney's refusal be reversed, and that the present application be approved to be passed to publication.

Respectfully Submitted,

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By: Brian R. McGinley
*One of the Attorneys for Applicant Shelter
Mutual Insurance Company*

Brian R. McGinley
Kate E. Hart
Dentons US LLP
P.O. Box #061080
Wacker Drive Station, Willis Tower
Chicago, IL 60606-1080
Ph: 312.876.8000
Fax: 312.876.7934

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